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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,878	01/24/2002	Alexander Bublewitz	P66496US1	7201

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LAW OFFICES OF  
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WASHINGTON, DC 20004

EXAMINER
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ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/053,878

**Applicant(s)**

BUBLEWITZ ET AL.

**Examiner**

Marc S. Zimmer

**Art Unit**

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 51-74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51-53, 56-61 and 64-74 is/are rejected.
- 7) ☒ Claim(s) 51-74 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### ***Claim Objections***

Claims 51-74 are objected to because the characterization of component (d2) is misleading in view of Applicant's most recent claim amendments. This component may no longer have more than one silicon-bound alkoxy group hence the phrase *at least one* Si-OR structural unit should be removed. Note that this phrase appears twice in the claim.

### ***Response to Arguments***

It is the Applicant's position that (d1) is no longer taught by King in view of the meaning currently assigned to the variables  $R^1$ ,  $R^3$ ,  $R^4$ , and X. In this connection, Applicant states the following"

"This is because King component (F) mandatorily comprises either two alkenyl- or two alkynyl residues (cf. column 5, lines 38-39; column 3, line 3). Whereas, component (d1), according to the present claims, contains if any, only one alkenyl group."

In the Examiner's estimation, Applicant has interpreted the metes-and-bounds of the description of (d1) too narrowly. The variable "X" represents a polysiloxane without any indication being provided as to what substituents are present (other than  $C\equiv C-R^1$  and  $R^2$  of course). Given the general manner in which X is disclosed, this variable embraces all polysiloxanes including those containing a plurality of alkenyl-, alkynyl-, or any other functional group. That is, it is incorrect to assert that (d1) may only contain a single alkenyl or, for that matter, alkynyl group because there are no limits placed on what substituents may be bonded to the polysiloxane backbone.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 51-53, 56-60, 64, and 67-68 are rejected under 35 U.S.C. 102(b) as being anticipated by King et al, U.S. patent # 5,696,209. King discloses a dual-curable polysiloxane-based adhesive composition comprising each of the following essential ingredients (column 2):

- (A) an alkenyl-functionalized MQ resin,
- (B) an organohydrogenpolysiloxane (column 4, lines 11-41),
- (C) a silane adhering to the formula  $R^{1}_{4-y}Si(OR^2)_y$ ,
- (D) a platinum hydrosilylation catalyst (column 4, lines 65-67 through column 5, lines 1-9), and
- (E) a condensation catalyst selected from, among others, stannous octoate, dibutyltin diacetate, and bis(acetylacetonatyl) diisopropyltitanate (column 5, lines 14-27)

Notably, King mentions as an optional component (F) an alkene- or alkyne-functionalized polydiorganosiloxane having a viscosity of from 100 to 80,000 mm<sup>2</sup>/s.

Therefore, in instances where (F) is incorporated along with (A) through (E), their invention corresponds to the embodiment of the instant invention wherein both (d1) and (d2) are present. Other optional materials include fillers, antioxidants, pigments, and

heat stabilizers (column 6, lines 61-63). Insofar as fillers are generally of the reinforcing or non-reinforcing type, claim 4 is anticipated by King's mention of fillers. Solvents (inert carriers) are also contemplated in column 7.

The above composition may be formulated in one- or two parts. If it is desirable to prepare the composition in two parts, King advocates formulating (A), (B), and (F) as one part and (A), (C), (D), (E), and (F) as a second part (column 7, lines 31-48).

As for claim 56, where X is an oligo/polysilicic acid, the claim is anticipated in view of King's admission that (A) is a resinous silicone.

As for claims 60 and 64, amines, polyamines, phosphines, and maleic acid derivatives are among the compounds to be employed as hydrosilylation catalyst inhibitors according to column 6, lines 1-15. Further, one of ordinary skill will appreciate that these same compounds will also lower the reactivity of the condensation catalyst present. In each instance, catalyst activity is modified by reversibly coordinating to the active metal center thereby reducing the number of coordination sites available at which reaction may occur.

Claim 67 calls for the incorporation of MQ resins that would be satisfied by component (A) of King's invention.

### ***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

**(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 69-74 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over King et al., U.S Patent # 5,696,209. Insofar as the compositions disclosed by King and Applicant mirror one another in virtually every respect, it is the position of the Office that the multiple-stage cure and the properties recorded at each step will be inherent in King's composition. "[P]roducts of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). See also *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established."

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 61, 65, and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over King et al., U.S. Patent # 5,696,209 in view of Lutz et al., U.S. Patent # 6,201,055. Though King makes cursory mention of fillers at column 6, line 62, there is no indication as to what fillers are most useful in the formulation their addition-curable PSA. Lutz, on the other hand, instructs that silica is an important additive where the PSA is to be employed in the manufacture of electronic devices (see column 8, lines 10-16 of *King*) for its ability to lower the coefficient of thermal expansion of the composition (column 1, lines 41-52 and column 2, lines 1-5). Concerning claim 12, one of ordinary skill will appreciate that silica inherently contains surface bound water molecules unless measures are taken to remove the adventitious water prior to use. No such steps appear to be disclosed by Lutz hence the silica recommended as an additive by that reference will inherently donate water in the composition disclosed by King.

***Allowable Subject Matter***

Claims 54-55 and 62-63 are objected to as being dependent upon a rejected base claim, but would be allowable over the prior art if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 10, 2004



MARGARET G. MOORE  
PRIMARY EXAMINER